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In the Supreme Court of the United States

OCTOBER TERM, 1944

No. 469

SPECIAL EQUIPMENT COMPANY, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The findings of fact and conclusions of law of the United States District Court for the District of Columbia (R. 9-11) were entered without an opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 142-152) is reported in 62 U. S. P. Q. 12.

JURISDICTION

The judgment of the Court of Appeals was entered on June 19, 1944 (R. 153). A petition for rehearing (R. 153-158) was denied on July 18, 1944 (R. 163). The petition for a writ of certiorari was filed on September 15, 1944. The juris-

diction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTIONS PRESENTED

1. Whether the court below erred in affirming the judgment of the district court which, in turn, upheld the rejection of subcombination claims in the Patent Office on the ground that they were incomplete, misleading, and broader than the invention.
2. Whether the court below properly held the subcombination unpatentable because petitioner's purpose in seeking a patent on the subcombination was to exploit and protect the patent monopoly of the complete machine.

STATUTE INVOLVED

The relevant provisions of Sections 4886, 4888, and 4915 of the Revised Statutes (35 U. S. C. Secs. 31, 33, and 63) are set forth in the Appendix, *infra*, pp. 13-15.

STATEMENT

Petitioner's assignor applied for a patent in 1932 upon a fruit-treating apparatus which bobbed, split, pared, and cored pears for canning and other purposes. The apparatus is a machine having two turrets, and operates as follows: The whole pear is introduced into one of the turrets, which rotates it past a bobbing device that cuts the top off. The fruit is then passed over a splitting knife which bisects it lengthwise. The two

halves are then separated and transferred to the second turret where each half is separately peeled and cored. (R. 9, 130-131.) The application as filed contained claims covering the entire machine, and also a claim which covered all the features of the machine except the splitting knife. The latter claim was rejected by the Examiner and the Board of Appeals in the Patent Office as being, "incomplete, misleading and broader than the invention" because it implied that the mechanism can peel whole pears, whereas the application disclosed a mechanism for peeling and coring half pears but not whole pears. (R. 132.) After cancellation of this claim, the other claims in the application were allowed in 1938 and the patent for them was "ordered to issue upon payment of the final fee". (R. 2, 124).

In 1939, petitioner's assignor renewed the application (R. 125) and presented four new claims (Nos. 38, 39, 41, 44), claiming an automatic machine for bobbing, peeling, and coring pears, but again making no mention of any cutting device for halving the pears before coring and peeling. The Examiner again rejected these claims as being "incomplete, misleading and broader than the invention" because they imply, contrary to the fact, that the machine "pares and cores whole fruit". (R. 131-132.) The Board of Appeals affirmed, saying (R. 134-135):

Nowhere in the original specification or original claims covering the combination of

the two turrets was there any indication given that the splitting means can be omitted. The entire disclosure relates to the preparation of the pears by starting with whole pears. The holding means on the first turret are so shaped that they fit whole pears and hold them firmly while they are being operated on. A number of parts are so shaped that they are specially adapted to handle or operate on whole pears. The timing of the parts is such that the cutter comes into operation at a certain time during the preparation of the pears in the machine. The parts in the second turret are intended and adapted for paring and coring split pears and could not be used for paring and coring whole pears. It seems to us that the pear-splitting mechanism is an essential part of the machine and the entire machine was constructed with a view of starting with whole pears and splitting them.

While conceding that "subcombination claims may be obtained in addition to claims to the entire combination," the Board of Appeals rejected the subcombination because the claims without a pear-splitting means covered a construction "never contemplated by applicant," there being "no indication that the construction claimed can or was ever intended to accomplish a result" (R. 135).

Petitioner's assignor¹ then brought this suit in the United States District Court for the District

¹ Petitioner was substituted as party plaintiff by order of the district court dated January 26, 1943 (R. 13-14).

of Columbia under Revised Statutes, section 4915 (35 U. S. C. 63), to compel the Commissioner of Patents to issue a patent containing the four rejected claims (R. 2-5). After a trial, the district court dismissed the complaint (R. 11), finding as facts that "as disclosed in the application the bobbing means can act only on whole fruit and the paring and coring means only on half fruit"; that, as disclosed in the application, "the splitting knife is an essential element of the combination and without it the two turrets could not combine to produce any useful result"; that "because of the omission of this essential element the claims are incomplete"; and that they therefore do not properly define petitioner's invention as required by Revised Statutes, section 4888 (R. 9-10).

The court below affirmed the judgment of the district court (R. 153). Without deciding whether the ground of rejection in the district court was correct, the court below held that even if the subcombination claims "present a distinct and useful invention," a patent thereon must be denied because petitioner's purpose in making the claims thereon was not to use it or license others to use it, but "to exploit and protect the patent monopoly of another related invention, to wit: the complete machine" (R. 143).

ARGUMENT

1. While the ground upon which the court below rested its decision poses a question of unde-

niable importance, we suggest that the case does not afford an appropriate vehicle for its consideration. This is so because the ground of decision in the Patent Office and the district court, involving a settled principle of no general importance, is clearly supported by sufficient evidence.

In upholding the rejection of these claims by the Patent Office, the district court found that the splitting knife is an essential element of the combination; that the machine without it was not the invention disclosed in the application; and that since the rejected claims do not accurately describe the invention, they are not a true sub-combination (R. 9-10). These findings are, of course, not to be set aside unless clearly wrong. Rule 52 (a), F. R. C. P.; *Adamson v. Gililand*, 242 U. S. 350; *Warren v. Keep*, 155 U. S. 265; *General Motors Corp. v. Coe*, 120 F. (2d) 736 (App. D. C.), certiorari denied, 314 U. S. 688, rehearing denied, 314 U. S. 715; *Hydraulic Press Corp. v. Coe*, 134 F. (2d) 49 (App. D. C.).

That there was clear error in these findings the court below did not and could not hold. The record shows that while the splitting device can be eliminated from the machine without interfering with the other operations of bobbing, peeling, and coring, to do so would involve pre-splitting the pears, holding the halves together face to face, and carefully and accurately placing them

together in the machine (R. 20, 27).² Splitting pears before bobbing them is a practice which, for obvious reasons, has never been commercially adopted, whether these operations were performed by hand or by machine (R. 16, 24). Indeed, the labor requirements for petitioner's machine are doubled when the cutting device is removed therefrom (R. 18, 26). And although petitioner's machine has been in use in canneries since 1931 (R. 15), it was not until 1941 or 1942 that pre-split pears were first put into a bobbing machine, and then it "was tried out" only at the suggestion of petitioner's attorney (R. 23-25).³ The verdict of petitioner's own witness was that use of the machine minus the splitting device was "a disadvantageous method" of preparing pears (R. 25).

Without deciding whether the ground of decision in the district court was erroneous, the opinion of Justice Arnold in the court below, in which the other two judges concurred, characterized it as resting "on a very slender foundation" (R. 142), and stated that "it seems more plausible to say that the subcombination does produce a use-

² Since the ability to use the subcombination in this way was not disclosed by the claims in question, it may not be used to justify their allowance. *Abbott v. Coe*, 109 F. (2d) 449 (App. D. C.).

³ According to petitioner's witness Skog, "This was done on one Sunday—we did not want to publicize the fact too much—" (R. 20), and motion pictures, later introduced in evidence in the district court (Pl. Ex. 6), were taken of the operation.

ful result and that two distinct inventions are disclosed in the application" (R. 143). But the court did not hold that there was inadequate evidence to support the contrary view of the Patent Office and the district court. On the contrary, it adverted to the fact that the partial machine "is not designed" for use without the cutting knife; that "it is only an artificial and clumsy substitute for the complete machine"; and that "there is no rhyme or reason for manufacturing such a partial machine when there is available the complete machine which does the cutting mechanically" (R. 143).*

The claims in question, being incomplete in omitting an essential element of the machine and not indicating how the claimed subcombination can be used alone, were properly rejected. *Goodman v. Super Mold Corp.*, 103 F. (2d) 474 (C. C. A. 9); *Rodman Chemical Co. v. Deeds Commercial Laboratories*, 261 Fed. 189 (C. C. A. 7); *Loggie v. Puget Sound Mills and Timber Company*, 194 Fed. 158 (W. D. Wash.). See also *Ideal Roller*

* Justices Miller and Edgerton concurred in Justice Arnold's opinion (R. 148, 152). While Justice Miller in his separate concurring opinion disagreed with the findings of the district court (R. 148), he approved and adopted the finding of the Board of Appeals "that the claims as drawn * * * cover constructions never contemplated by applicant" (R. 148), and found that when the partial machine is compared with the complete machine "its utility is lessened, to say the least; and the subcombination claims become suspect" (R. 152). Justices Arnold and Edgerton also concurred in the opinion of Justice Miller (R. 148, 152).

and Manufacturing Co. v. Sutherland Paper Co.,
96 F. (2d) 675, 677 (C. C. A. 6).

2. As we have indicated above (p. 5), the court below based its affirmance of the district court's judgment (R. 153) on findings that petitioner's "purpose in making a distinct patent claim on the subcombination is not to stimulate the commercial development or financial return from that patent," but "to exploit and protect the patent monopoly of another related invention, to wit: the complete machine. There is no intention to make or license others to make the partial machine". (R. 143.)⁵ The court reasoned that the petitioner could not use his patent on the subcombination, if granted, "to enlarge the scope of the patent on the complete machine and to exploit and

⁵ The record amply supports these findings. The Board of Appeals in the Patent Office found that the subcombination claims "are incomplete and cover constructions never contemplated by applicant" (R. 135). Petitioner, in its brief in the court below, stated: "The claims in issue are sought purely to prevent appropriation of the * * * machine by the obvious expedient of eliminating the splitting mechanism" (p. 17), an admission repeated by petitioner in its oral argument below (R. 149). Justice Arnold specifically found that the subcombination "is not designed for" use without the pear-splitting device; that "it is only an artificial and clumsy substitute for the complete machine. It requires that the fruit first be cut in half and then the two halves joined together by hand before they are inserted. There is no rhyme or reason for manufacturing such a partial machine when there is available the complete machine which does the cutting mechanically." (R. 143.) These findings by Justice Arnold have complete support in the testimony of petitioner's only witness (R. 16, 18, 20, 23-27).

secure the business carried on in connection with that patent" (R. 146-7), and that, therefore, "distinct patent rights" to the subcombination should not be granted to petitioner "for the sole purpose of handicapping future inventors whose discoveries would not otherwise infringe the complete patent" (R. 148).

While, for the reason stated above (pp. 5-6), we do not believe this case an appropriate one for consideration of this important issue, we submit that this issue was properly decided below. This Court has held that a patentee may not enlarge the scope of his patent monopoly by tying to the use of the patented device or process, the use of other devices, processes, or materials, patented or not. *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U. S. 502; *Carbice Corporation v. American Patents Corp.* 283 U. S. 27, 31; *Leitch Manufacturing Co. v. Barber Co.*, 302 U. S. 458; cf. *United Shoe Machinery Co. v. United States*, 258 U. S. 451, 462-464; *International Business Machines Corp. v. United States*, 298 U. S. 131, 140. Nor may he use it to exploit a second patent monopoly not embraced in the first. *Ethyl Gasoline Corporation et al. v. United States*, 309 U. S. 436. In that case, this Court said (at 459):

The patent monopoly of one invention may no more be enlarged for the exploitation of a monopoly of another, see *Standard Sanitary Mfg. Co. v. United States*, *supra*, than

for the exploitation of an unpatented article, *United Shoe Machinery Co. v. United States*, *supra*; *Carbice Corporation v. American Patents Corp.*, *supra*; *Leitch Manufacturing Co. v. Barber Co.*, *supra*; *American Lecithin Co. v. Warfield Co.*, 105 F. (2d) 207, or for the exploitation or promotion of a business not embraced within the patent. *Interstate Circuit v. United States*, *supra*, 228-230.

Moreover, "In construing and applying the patent law so as to give effect to the public policy which limits the granted monopoly strictly to the terms of the statutory grant, * * * the particular form or method by which the monopoly is sought to be extended is immaterial." *United States v. Univis Lens Co., Inc. et al.*, 316 U. S. 241, 251-2.⁶

In denying to petitioner a patent which, if issued, could, within the principles of the foregoing cases, neither be enforced in an infringement suit nor defended in an injunction proceeding, the court below was plainly avoiding useless procedure.

In any event, denial of a patent on the subcom-

⁶ This Court has also held that a patentee may not use his patent monopoly so as to control resale prices by the purchaser of the patented article. *Bauer & Cie v. O'Donnell*, 229 U. S. 1; *Straus v. Victor Talking Machine Co.*, 243 U. S. 490; *Boston Store v. American Graphophone Co.*, 246 U. S. 8; cf. *Adams v. Burke*, 17 Wall. 453; *Bobbs-Merrill Company v. Straus*, 210 U. S. 339; *United States v. General Electric Co.*, 272 U. S. 476, 485.

bination need not prejudice petitioner, or its complete use and enjoyment of the patent on the complete machine, for, as stated by the court below, "If someone develops a new machine that imitates appellant's machine too closely it will infringe the principal patent and the subcombination claim will be superfluous" (R. 143).⁷

CONCLUSION

The decision of the court below is supportable upon grounds of no general importance. There is no conflict. We respectfully submit, therefore,

⁷The conclusion below is supportable on still another ground. The patent application here involved is a renewal application filed under Revised Statutes, Sec. 4897, and Patent Office rule 175 (37 C. F. R. 1.175), which limit renewal to claims for the same invention for which a patent was ordered to issue on the original application. When the claims allowed in the original case are directed to one combination or subcombination of elements, the renewal cannot be allowed to embrace claims to a different combination. *In re Kaisling*, 44 F. (2d) 863 (C. C. P. A.). The claims allowed in the original application here were directed to the combination including the splitting means (R. 132, 2, 124; see p. 3, *supra*), and the Board of Appeals found that this was the only invention to which the specification and allowed claims were directed (R. 134-5, quoted at pp. 3-4, *supra*). Consequently, claims to a different combination of elements omitting the splitting means could not be allowed in the renewal. This question cannot arise in future cases since the renewal law has now been repealed (Act of August 9, 1939, c. 619, Sec. 1, 53 Stat. 1293), but the saving clause (*idem*, Sec. 4) makes that law applicable to these proceedings.

that the petition for a writ of certiorari should be denied.

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OCTOBER 1944.

APPENDIX

Section 4886 of the Revised Statutes (35 U. S. C. 31) provides:

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.

Section 4888 of the Revised Statutes (35 U. S. C. 33) provides in part:

Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any

person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor * * *.

Section 4915 of the Revised Statutes (35 U. S. C. 63) provides:

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and

otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

